

REMARKS

I. Summary of the Examiner's Action

A. Claim Rejections

In paragraph 3 of the Office Action, the Examiner rejected claims 1 – 3 and 10 – 17 under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application Publication No. US 2005/0064862 A1 to Castrogiovanni et al. (hereinafter “the Castrogiovanni application”).

B. Allowable Subject Matter

In paragraph 4 of the Office Action, the Examiner object to claims 4 – 9 as being dependent upon a rejected base claim, but indicated that the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

II. Applicant's Response – Claim Rejections

A. Rejection of Claims 1 – 3 and 10 – 17 under 35 U.S.C. § 102(e)

Applicant has amended claim 1 so that it recites:

1. A method for instituting a SIM (Subscriber Identity Module) facility in digital wireless terminal equipment . . . the method comprising:

“downloading at least a main part of the application-, subscriber- and network-specific data of the SIM facility into the terminal equipment

through the data communication network, where the application-specific data further comprises SIM logic and algorithms; and

implementing the SIM facility in the terminal equipment using the application-, subscriber- and network-specific data . . .”

Applicant respectfully submits that it is not seen where the Castrogiovanni application either describes or suggests the subject matter of the foregoing portion of claim 1. Applicant has similarly amended independent claims 16 and 17.

Applicant respectfully submits that the disclosure of the Castrogiovanni application differs considerably from Applicant's invention. Castrogiovanni does not concern the downloading of SIM functionality to terminal equipment as now recited in claim 1. Instead, the Castrogiovanni application relates to the testing of different kinds of devices in different coverage areas of the network system *i.e.*, Castrogiovanni's target is to assure performance of the devices. Castrogiovanni's purpose is to provide a test environment for wireless equipment manufacturers and wireless network operators. In this test environment, the manufacturers and operators may test their equipment by using different kinds of subscriber data in different coverage areas of the network. Only after these tests are successfully performed will the equipment be delivered for sale.

In addition to the above, in the Castrogiovanni application SIM information that is downloaded to equipment includes only subscriber identity/subscriber configuration information. A thorough review of the Castrogiovanni application indicates that this definition has been adopted throughout the Castrogiovanni application, for example:

“. . . including SIM information such as the subscriber identification information (e.g., IMSI) and/or subscriber configuration information, as discussed in detail with reference to FIG. 12.”

Paragraph 105, page 6, lines 7 – 10. In contrast to Applicant’s invention, the limited SIM information of Castrogiovanni will not implement SIM functionality because it does not include the necessary firmware (e.g., SIM logic and algorithms). In order for the SIM information provided to terminal equipment in Castrogiovanni to be operable, the equipment of Castrogiovanni must be separately equipped with SIM functionality, since the SIM information itself does not provide this functionality.

Applicant respectfully submits that it is not seen where in the Castrogiovanni application the claimed feature of downloading SIM functionality to terminal equipment is found. The embodiment described in Catrogiovanni permits a client to “adopt” the status of a proxy device (such as, for example, a PDA device) over the network and as a result of this “adoption” the client may lease or rent operator services and network functionality, *etc.*, allocated for the device. In the present invention the terminal equipment does not remotely control any proxy device or even other devices. After SIM information capable of implementing SIM functionality is successfully downloaded to terminal equipment in Applicants’ invention, the equipment functions as an individual communication device which is operable in a communications networks. Applicant’s invention is simply unrelated to the leasing of SIM identity information.

In addition, when Castrogiovanni speaks of “downloading” it is not referring to the downloading of SIM functionality over the network, but instead to the linking of services to the device owned by the client (see, for example, stage 538 in FIG. 17; *i.e.*, linking, not downloading!). In Castrogiovanni, the expression “downloading” refers to conventional downloading of files, services, music, videos etc. known in the prior art, but not to the downloading of SIM functionality to the client’s own device, which is the object of the present invention and which must be in the device before these value added services *etc.* may be downloaded.

In addition, when considering the subject matter of original claim 13 and 14 (now cancelled) which is presently recited by the independent claims, Applicant respectfully submits that it is not seen how the Castrogiovanni application relates to them. Applicant assumes that the term “logically” in paragraphs [0073, 0074] has apparently been misunderstood by the Examiner. This term and, in general, these paragraphs do not have any relevance to the downloading of SIM logic (or algorithms) to terminal equipment. As can be seen, these paragraphs describe how SIM information, as that term is used in the Castrogiovanni application, is stored SIM servers. These paragraphs, however, do not describe or suggest the downloading of SIM data including means for implementing SIM functionality as in the case of Applicant’s claims.

When considering the subject matter of cited paragraphs [0009, 0133] relied upon by the Examiner in Castrogiovanni it becomes clear that these paragraphs also do not

Commissioner for Patents
Application Serial No. 10/618,396
August 4, 2005
Page 13

teach anything about the downloading of SIM functionality over a network. These paragraphs only illustrate the algorithms that belong to the SIM facility [0009] and the utilization of them when performing communications operations [0133]. Notably, these paragraphs say nothing about how the SIM functionality itself is instituted in the terminal equipment.

The Applicant joins with the Examiner's observation that the other documents cited in the Office Action and also the references found by the other authorities only represent the general prior art and have no relevance to the instant invention.

For the foregoing reasons, Applicant respectfully submits that claim 1 is patentable over the Castrogiovanni application. Applicant therefore respectfully requests that the rejection of independent claim 1 be withdrawn. Applicant also respectfully submits that independent claims 16 and 17 are patentable for reasons similar to those recited with respect to claim 1, and for reasons attributable to their unique features. Applicant therefore respectfully requests that the rejection of independent claims 16 and 17 be similarly withdrawn. Finally, Applicant respectfully requests that the rejection of dependent claims 2 – 3, 10 – 12 and 15 be withdrawn since they depend from claims that are patentable for the foregoing reasons.

Commissioner for Patents
Application Serial No. 10/618,396
August 4, 2005
Page 14

B. New Claim 18

Applicant has also added new claim 18, which is patentable for the foregoing reasons.

III. Conclusion

The Applicant submits that in light of the foregoing remarks the application is now in condition for allowance. Applicant therefore respectfully requests that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

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Date

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